

The opinion in support of the decision being entered today was not written for publication and
is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOEL L. PASSKE,
FRED DOJAN, K. PETER HAZENBERG
and
JOHN F. SWIGART

Appeal No. 2004-1294
Application No. 09/887,523

HEARD: August 17, 2004

Before KIMLIN, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-16 which are all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are directed to footwear with a filter system that restricts liquids and particulates from entering a bladder within the footwear. Claim 1 is illustrative:

1. An article of footwear for receiving a foot of a wearer, said article of footwear comprising:
 - an upper for covering at least a portion of the wearer's foot;
 - a sole structure attached to said upper;
 - an air-filled bladder in fluid communication with ambient air and attached to said article of footwear; and
 - a filter in fluid communication with said bladder and ambient air, said filter being structured to permit ambient air to enter said bladder and restrict liquids and particulates from entering said bladder.

As evidence of unpatentability, the Examiner relies upon the following prior art references:

Reed et al. (Reed)	US 5,845,417	Dec. 8, 1998
Di Girolamo (Opal) (European Patent Application)	EP 1,074,193 A1	Feb. 7, 2001
Colesnicenco ¹ (French Patent Application)	FR 2,670,369 A1	Jun. 19, 1992

¹We rely upon and refer to the English translation of record.

We additionally rely upon the following prior art reference:

Rogers US 6,582,113 B2 Jun. 24, 2003
(eff. filing date: May 14, 1998)

The Examiner maintains two rejections:

1. Claims 1-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reed in view of Opal.
 2. Claims 1-14, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Colesnicenco in view of Opal.

We reverse with respect to the rejection over Reed in view of Opal. We affirm with respect to the rejection over Colesnicenco in view of Opal. Because our reasons differ from those of the Examiner and we rely upon additional evidence of obviousness, we designate our affirmance as involving new grounds of rejection pursuant to our authority under 37 CFR § 41.50(b).² The new rejections are as follows:

1. We reject claims 1 and 8 under 35 U.S.C. § 102(b) as anticipated by Colesnicenco.
 2. We reject claims 2-7, 9-14 and 16 under 35 U.S.C. § 103(a) as unpatentable over Colesnicenco in view of Opal and Rogers.

Our reasons follow.³

² 37 CFR 41.50(b)(effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) has replaced 37 CFR § 1.196(b).

³Because we are presenting new grounds of rejection, we will address all the claims rather than select representative claims from the groupings set forth by Appellants.

OPINION

To start, we will present our new grounds of rejection.

New Ground of Rejection over Colesnicenco

We reject claims 1 and 8 under 35 U.S.C. § 102(b) as anticipated by Colesnicenco. We address claim 1 first.

While the Examiner combined Opal with Colesnicenco to reject claim 1, claim 1 is of such breadth that Opal is unnecessary to the rejection. This is because Colesnicenco teaches each and every limitation of claim 1 either expressly or inherently as required under 35 U.S.C. § 102.

See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997)(“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.”).

As set forth in the Examiner’s rejection, Colesnicenco describes an article of footwear having an upper, a sole structure, and an air-filled bladder as well as a filter in communication with the bladder as required by claim 1 (Answer, p. 5). This is not disputed by Appellants (Brief and Reply Brief in their entirety). The Examiner applied Opal as evidence that an expanded polytetrafluoroethylene (ePTFE) membrane material would have been an obvious material for the filter of Colesnicenco. However, claim 1 does not require that the filter material be ePTFE, it only requires the filter material be one that “restricts” liquids and particulates from entering the bladder.

Appellants have chosen, in claim 1, to define the filter in terms of what it *does* rather than what it *is*. Choosing this manner of defining a claimed structure carries with it a risk: The risk that the claim will not distinguish the claimed structure from that of the prior art. *Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432. Here, Appellants have chosen to define the filter in terms of its function, i.e., the function of restricting liquids and particulates from entering the bladder. But, as pointed out by the Examiner, the word “restrict” is a broad term: The filter need not prevent all liquid from entering the bladder (Answer, pp. 8-9). Moreover, we note that the reference need not specifically state that liquid is restricted, it is enough that such restriction inherently occurs. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Colesnicenco specifies the use of felt or another filtering material for the filter (Colesnicenco, p. 3, ll. 20-22). As Appellants point out: “Felt is recognized as a cloth made of wool and fur often mixed with natural or synthetic fibers, or felt may be a firm woven cloth of wool or cotton heavily napped and shrunk.” (Brief, p. 8 citing *Merriam-Webster’s Collegiate Dictionary*, Tenth edition 2000). That felt would “restrict” the passage of liquid is inherent from the nature of felt filters.

We conclude that it is reasonable to believe that the felt filter described by Colesnicenco would restrict both liquids and particulates from entering the bladder. Given that there is a reasonable basis to believe that the function of restricting liquids and particulates is inherently met by the felt filter of Colesnicenco, it is reasonable to shift the burden to Appellants to prove that, in fact, the prior art filter does not necessarily or inherently possess the characteristics of the

claimed product. *Best*, 562 F.2d at 1254-55, 195 USPQ at 433. Appellants have not yet presented objective evidence to the contrary.

Because Colesnicenco anticipates the footwear of claim 1, there is no need to address Appellants' argument that there is no motivation to combine the teachings of Opal with those of Colesnicenco.

As further required by claim 8, the bladder (6) is located in the sole structure of the footwear of Colesnicenco. Therefore, Colesnicenco anticipates the footwear of claim 8 as well.

New Rejection of Claims 2-7, 9-14 and 16 over Colesnicenco in view of Opal and Rogers

As we explained above, Colesnicenco describes an article of footwear having the upper, sole structure, bladder, and filter required by claim 1. Colesnicenco states that the filtering material (1b) placed in the port (2) is a material "such as felt or another filtering material." (Colesnicenco, p. 3, ll. 20-22). It would have, thus, been obvious to one of ordinary skill in the art to select air filter materials known at the time of the invention for use as the filtering material (1b) of Colesnicenco. Rogers provides evidence that the filter materials of the claims were known at the time of the invention. As we explain below, there is a *prima facie* case of obviousness for each of the claims.

Claims 2, 3, 9, and 10

Claims 2 and 9 limit the filter to those including polytetrafluoroethylene (PTFE) and claims 3 and 10 further limit the material to expanded polytetrafluoroethylene (ePTFE). Rogers provides evidence that ePTFE filter materials for air filtering were known in the art (Rogers, col.

3, ll. 63-64). The ePTFE is used in air breather filters for allowing air passage while preventing passage of contaminants such as particulate matter, water and/or oily materials (Rogers, col. 10, ll. 29-35). Opal provides evidence that ePTFE membranes were known for use in footwear for allowing air flow, but preventing or restricting liquid flow (Opal, col. 3, ll. 38-45). It would have been obvious to one of ordinary skill in the art to use an ePTFE membrane material as the filter material in Colesnicenco as the evidence as a whole indicates that ePTFE was conventionally used as an air filter material in ports so as to prevent or restrict contaminants from entering the compartment on the other side of the port.

Claim 4

Claim 4 requires that the filter include a material from the group consisting of high density polyethylene, ultrahigh molecular weight polyethylene, polyvinylidene fluoride, polypropylene and ceramic filter materials. Rogers indicates that at least one of these materials was known for use in air filters: Polypropylene (col. 11, ll. 16-23). Rogers also indicates that polyethylenes were known (*Id.*).⁴ It would have been obvious to one of ordinary skill in the art to use any of the conventional air filter materials in the filter of Colesnicenco. Polypropylene, as evidenced by Rogers, was a known air filter material and thus it would have been an obvious choice to one of ordinary skill in the art for use as the filter material of Colesnicenco.

⁴The Examiner stated in the Answer (p. 8) and Appellants also acknowledged in the hearing that the materials of claim 4 were known as filter materials at the time of the invention.

Claims 2-7, 9-14, and 16

Rogers also specifically discloses a laminated filter material having an ePTFE layer and a scrim layer of, for instance, polypropylene (Rogers, col. 5, ll. 51-54) in accordance with the filter requirements of claims 2-4, 9, and 10. In accordance with claims 5 and 11, the laminated filter has hydrophobic and oleophobic properties due to the treatment of ePTFE, a hydrophobic material (col. 4, l. 8), with an oleophobic enhancement agent (col. 6, ll. 30-33). In accordance with claims 6, 7, 12, and 13, the scrim layer is a perforated layer which prevents large particles and objects from contacting the filter, but permits air to access the filter (Scrim 224, Rogers, Fig. 3 and col. 10, ll. 1-35 in conjunction with col. 5, ll. 19-30). It would have been obvious to one of ordinary skill in the art to use the filtering material of Rogers as the filter material (1b) of Colesnicenco because Rogers teaches that the filtering material disclosed therein is useful as a breather filter placed within a port and that the laminated filter material allows the flow of air through the filter while preventing or restricting the flow of particles and other contaminants such as water, oil and other organic compounds through the filter (Rogers, col. 10, ll. 24-35 and col. 11, 32-35).

When one of ordinary skill in the art follows the suggestions of the prior art and uses the ePTFE filter material in the filter of Colesnicenco, the filter would be located in the upper as required by claim 16.

The evidence as a whole indicates that the subject matter of claims 2-14 and 16 is *prima facie* obvious as evidenced by Colesnicenco, Rogers, and Opal taken as a whole.

Reed in view of Opal

Because Reed expressly states that liquid may be drawn through the filter 214, we agree with Appellants that there is no motivation to use the waterproof membrane of Opal, which does not allow liquid water to move across it, as the filter material of Reed. Therefore, we conclude that the Examiner has failed to establish a *prima facie* case of obviousness over Reed in view of Opal.

CONCLUSION

To summarize, we affirm with respect to the rejection of claims 1-14 and 16 under 35 U.S.C. § 103(a) over Colesnicenco in view of Opal, but we denominate our affirmance as involving new grounds of rejection. Particularly, we reject claims 1 and 8 under 35 U.S.C. § 102(b) as anticipated by Colesnicenco and we reject claims 2-7, 9-14, and 16 under 35 U.S.C. § 103(a) over Colesnicenco in view of Rogers and Opal. We reverse with respect to the rejection of claims 1-16 under 35 U.S.C. § 103(a) over Reed in view of Opal. Because the rejection of claim 15 is not sustained, our decision is an affirmation-in-part.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

Regarding the new grounds of rejection, 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the Appellants elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

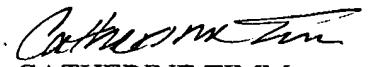
No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

37 CFR § 41.50(b)


EDWARD C. KIMLIN
Administrative Patent Judge

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BOARD OF PATENT
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